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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/065,203	09/25/2002	Ronald K. Hettinger	PU2011	8157
23454	7590	06/14/2004	EXAMINER	
CALLAWAY GOLF COMPANY 2180 RUTHERFORD ROAD CARLSBAD, CA 92008-7328			HUNTER, ALVIN A	
			ART UNIT	PAPER NUMBER
			3711	3

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/065,203

Applicant(s)

HETTINGER ET AL.

Examiner

Alvin A. Hunter

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 25 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/25/2002.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2 and 3 recite the limitation "the striking plate section" in line 1. There is insufficient antecedent basis for this limitation in these claims.

Claim 4 recites the limitation "the minor body" in line 1. There is insufficient antecedent basis for this limitation in the claim.

Claim 5 recites the limitation "the major body" in lines 2 and 3. There is insufficient antecedent basis for this limitation in the claim.

Claim 6 recites the limitation "the moment of inertia" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shaeffer et al. (USPN 5676606) in view of Sanchez (USPN 6688990).

In regards to claim 1, Shaeffer et al. discloses a golf putter having a body composed of a metal material, in particular aluminum, wherein the body has a front wall 18, a bottom wall 24, a ribbon wall which is defined by the outer periphery of the sole, and a ledge defined by the outer periphery of the body (See Figures 1, 2, and 3 and Column 4, lines 1 through 22 and Column 5, lines 55 through 60). The bottom wall and the ribbon wall define an internal cavity and have a heel mass and toe mass made up of element 16, and a crown portion 22 composed of a non-metal material, in particular plastic, wherein the crown portion has a top wall, a side wall, and a front wall and the crown portion is attached to the ledge of the body (See Column 4, lines 1 through 22 and Column 5, lines 55 through 60). Shaeffer et al. does not disclose the front wall thickness. Sanchez discloses a golf putter having a front wall with a thickness of 1/16 of an inch (See Paragraph bridging columns 2 and 3). One having ordinary skill in the art would have found it obvious to have a thickness of 1/16, as taught by Sanchez, in order to balance the weight of the golf club.

In regards to claims 2 and 3, Sanchez discloses the front wall having a thickness of 1/16 of an inch.

Claim 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art applied to claims 1-3, above, in view of Murphy et al. (USPN 6248025) in view of Carley (USPN 4532169).

In regards to claim 4, the prior art applied to claims 1-3 do not disclose the crown made of pre-preg plies. Murphy et al. discloses a golf club having a crown made of pre-preg plies (See Summary of the Invention). One having ordinary skill in the art would

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have found it obvious to make the crown of the prior art applied to claims 1-3 of pre-preg plies, as taught by Murphy et al., in order to increase the post-impact velocity of the club head. Carley discloses the use of a bulking material in conjunction with pre-preg plies (See Detailed Description). One having ordinary skill in the art would have found it obvious incorporate a bulking material, as taught by Carley, in order to ease the molding of the pre-preg plies.

Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art applied to claims 1-3, above, in view of Macera (USPN 4664385) and Murphy et al. (USPN 6248025) in view of Carley (USPN 4532169).

In regards to claim 7, the prior art applied to claims 1-3 do not disclose the crown made of pre-preg plies or stainless steel. Macera disclose a putter head being made of aluminum, stainless steel (See Column 2, lines 22 through 30). One having ordinary skill in the art would have found it obvious to make the body of t the prior art applied to claims 1-3 of stainless steel, as taught by Macera, being that it is a common suitable material for ptuuers. Murphy et al. discloses a golf club having a crown made of pre-preg plies (See Summary of the Invention). One having ordinary skill in the art would have found it obvious to make the crown of the prior art applied to claims 1-3 of pre-preg plies, as taught by Murphy et al., in order to increase the post-impact velocity of the club head. Carley discloses the use of a bulking material in conjunction with pre-preg plies (See Detailed Description). One having ordinary skill in the art would have found it obvious incorporate a bulking material, as taught by Carley, in order to ease the molding of the pre-preg plies.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-3, 5, and 6 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5, 10, and 12 of U.S. Patent No. 6663504. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6663504 claims the same structure except for the golf club being a putter type. Though the golf club of U.S. Patent No. 6663504 does not disclose a putter type golf club, the golf club is capable of being used as a putter, and therefore, anticipates the above claims.

Claim 4 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 4, 5, 10, and 12 of U.S. Patent No. 6663504 in view of Carley (USPN 4532169). U.S. Patent No. 6663504 claims the minor body made of pre-preg plies but does not claim having a bulking material. Carley discloses the use of a bulking material in conjunction with pre-preg plies (See Detailed

Description). One having ordinary skill in the art would have found it obvious incorporate a bulking material, as taught by Carley, in order to ease the molding of the pre-preg plies.

Claims 1-3, 5, and 6 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5, 10, and 12 of U.S. Patent No. 6575845. Although the conflicting claims are not identical, they are not patentably distinct from each other because U.S. Patent No. 6575845 claims the same structure except for the golf club being a putter type. Though the golf club of U.S. Patent No. 6575845 does not disclose a putter type golf club, the golf club is capable of being used as a putter, and therefore, anticipates the above claims.

Claims 4 and 7 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-5, 10, and 12 of U.S. Patent No. 6575845 in view of Carley (USPN 4532169). U.S. Patent No. 6575845 claims the above, and in addition, the minor body made of pre-preg plies but does not claim having a bulking material. Carley discloses the use of a bulking material in conjunction with pre-preg plies (See Detailed Description). One having ordinary skill in the art would have found it obvious incorporate a bulking material, as taught by Carley, in order to ease the molding of the pre-preg plies.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alvin A. Hunter whose telephone number is 703-306-

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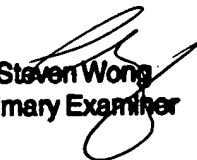
5693. The examiner can normally be reached on Monday through Friday from 7:30AM to 4:00PM Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Vidovich, can be reached on 703-308-1513. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AAA

Alvin A. Hunter, Jr.

  
Steven Wong  
Primary Examiner